

## REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 203-238 are in this Application. Claims 203-232 have been rejected under 35 U.S.C. § 102. Claims 1-102 have been canceled in a previous response. New claims 233-238 have been added.

### **35 U.S.C. § 102 Rejections**

The Examiner rejected claims 203, 210, 211, 220, 223 and 231 under 35 U.S.C. § 102(e) as being anticipated by Slatkine, and claims 203-209 and 211-232 under 35 U.S.C. 102(b) as being anticipated by Lai.

Applicant respectfully traverses the rejection and states that the Examiner has not established a *prima facie* case of anticipation regarding the claims since both Slatkine and Lai lack at least one limitation of the independent claims.

The following remarks relate primarily to the independent claims. The dependent claims are patentable at least by virtue of their dependency on their parent claims. While not all the dependent claims are separately argued in order to simplify the response, applicants submit that many of the dependent claims add patentable subject matter.

Independent claims 203, 211 and 220 recite, among other features, the feature the material is scanned by the laser beam within a duration of a pulse. It is submitted that neither Slatkine nor Lai anticipates the claims at least because none of Slatkine and Lai teaches or implies this feature.

### **Slatkine Does Not Teach Scanning Within A Duration Of A Pulse**

The Examiner refers to Figs. 3c and 3e of Slatkine, stating that Slatkine discloses a laser system for generating plurality of ablative laser pulses and a scanning assembly for dynamically diverting the laser beams, within a duration of a pulse of the plurality of pulses, so as to transfer a predetermined amount of energy to each one of a plurality of locations of the material.

Applicants respectfully disagree. Figs. 3c and 3e of Slatkine show surgery performed with a laser beam and scanner (Fig. 3c), and an ablative laser beam focused

on tissue in conjunction with a scanner (Fig. 3e). It is submitted that the skilled person would not understand Figs. 3c and 3e as teaching that the scanning assembly dynamically divert the laser beams within a duration of a pulse. Moreover, nowhere in Slatkine is there even a hint that the scanning assembly scans the material within a duration of a pulse. It is noted that the term "scanning" and its deflections is repeated approximately 30 times in Slatkine, but none of these occurrences even remotely suggests that the scanning is within the duration of a pulse.

### **Lai Does Not Teach Scanning Within A Duration Of A Pulse**

The Examiner refers to Figs. 1, 7A, 7B, 11, 11A and 12A-12B, stating that Lai discloses a laser system for generating plurality of ablative laser pulses, and a scanning assembly for dynamically diverting the laser beams, within a duration of a pulse.

Applicants respectfully disagree. Lai does not teach or imply dynamically diverting the laser beams within a duration of a pulse. On the contrary, Lai teaches a scan pattern in which each pulse is deposited at one location. Lai teaches two types of patterns: an orderly sequence (linear, circular, spiral), and a random sequence. However, in both types of patterns, there is no teaching of scanning with the duration of a pulse.

Figs. 7A and 7B of Lai, to which the Examiner is referring, show scan patterns. Each circle represents a circular etching of a different pulse (see for example, column 20 line 66 to column 21 line 3, and column 22 lines 34-41). Thus, contrary to the Examiner's contention, these figures do not show scanning within the duration of the pulse. Rather, these figures show scanning between pulses. Figs. 11, 11A and 12A-12B, to which the Examiner is also referring, show scanning devices, but does not describe the type of scanning, particularly not scanning within the duration of a pulse. The same applies also to Fig. 1 which is a block diagram that does not specify the type of scanning.

In light of the above arguments, the PTO is requested to withdraw the rejection of the claims.

**New Claims**

New claims 233, 235 and 237 recite the feature that the material is a hard tissue. Support for this feature is found throughout the specification as filed, see, *e.g.*, paragraph 1 of the published application (U.S. Published Application No. 20060189965).

New claims 234, 236 and 238 recite the feature that the material is selected from the group consisting of enamel, dentin and bone tissue. Support for this feature is found throughout the specification as filed, see, *e.g.*, paragraph 111 of the published application.

It is submitted that new claims 233-238 are not anticipated or rendered obvious by Slatkine or Lai at least because neither Slatkine nor Lai teaches or implies using laser radiation for ablating hard tissue, enamel, dentin and/or bone tissue. It is noted that both Slatkine and Lai are directed to ablation of soft tissue. Slatkine teaches epidermal or papillary dermal tissue, while Lai teaches corneal tissue, both of which are considered soft tissues.

In view of the above amendments and remarks it is respectfully submitted that claims 203-238 are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,

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**Enclosures:**

- Petition for Extension (Three Months)
- Additional Claims Transmittal Fee